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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/178,594	10/26/98	ISHIGURO	M U-WF-5103B-K

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HM22/0607

EXAMINER

BERCH, M

ART UNIT	PAPER NUMBER
1624	12

DATE MAILED: 06/07/00

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UNITED STATES DEPARTMENT OF COMMERCE
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 12

Application Number: 09/178594
Filing Date: 10/26/98
Appellant(s): Ishiguro

Milton J. Wayne
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed 4/10/2000.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

Art Unit: 1624

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 15-19 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

Art Unit: 1624

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 15-19 are rejected under 35 U.S.C. 112, paragraphs 1 and 2, as the claimed invention is not described, or is not described in such full, clear, and exact terms as to enable any person skilled in the art to make and use the same, and failing to particularly point out and distinctly claim the subject matter which applicant regards as his invention.

Five issues arise. With one exception noted below, every issue applies to every claim.

Lack of Description of Catalyst

There is a lack of description of the catalyst. Claim 15, which is not an original claim, lists two catalysts in the alternative. Choice (a), which is a broad genus of copper compounds, is not a problem. Choice (b), the mixture of zinc with anything in (a) is beyond what the specification actually says. No such language appears in any form in the specification or original claims. The use of Zinc itself is described. There is also in Example 9 the use of Zinc with the cuprous bromide dimethyl sulfide complex. But single example of zinc with one particular Copper complex does not constitute a description of zinc with all of (a). Appellants have pointed to material at page 8, lines 4-18. But this material does not mention Zinc, and

Art Unit: 1624

thus does not say that zinc can be mixed with anything in choice (a). That page 8 material simply describes what is in (a), which isn't the problem. The response in the Appeal Brief is largely in terms of enablement: "one of ordinary skill would certainly not expect that a mixture of zinc with such copper compounds would not work." However, as the examiner has repeatedly stated, the problem here is not a lack of enablement. The examiner does not question whether this would or would not work, only that the claim language is broader than the specification's language. The Appeal Brief says, "they contemplate a mixture of zinc's [sic, zinc] with at least one of the copper compounds of paragraph (a)." This is correct, but the claim language goes beyond that. Mixtures of Zinc with other than cuprous bromide dimethyl sulfide complex are simply never mentioned, alluded to, or embraced in any form (specific or generic), and there is no reason to think they were originally contemplated. This issue does not apply to Claim 19.

Lack of Description of X and Y

A second lack of description occurs in the definition of X and Y. Appellants have simply created two additional choices which were never in the specification. For example, X and Y can be a carboxyl group, COOH; see Appendix, page 8, last line, middle term. The Appeal Brief, from the middle of page 4 to the bottom of page 5, points to page 2, lines 13+, to page 15-17 and to the working examples. Nowhere in there, however, is the COOH group mentioned as a choice for X and Y. The same is true for the thiocarboxyl, COSH, which is in the Appendix, page 9, line 2, second term. Appellants argue that, "one of ordinary skill

Art Unit: 1624

would be aware that a wide variety of organic radicals could be present..." This is true; the specification does indeed set forth a wide variety of radicals, but that wide assortment does not include these two choices.

A second point arises in this matter of the definition of X and Y. From Appendix, page 8, last line, last term through page 9, line 4 are a number of specific ester groups. These are defined much more specifically than appears in the specification. Page 2, line 13-14 does, as appellants point out, have "substituted or unsubstituted ester group, substituted or unsubstituted thioester group." These are very general terms, not specifying what type of acid (e.g. carboxylic or sulfonic), which end the group is bound via (e.g. -C(O)OR or -O(O)CR) or even what the nature of the R group is. And for the "thioester" it is ambiguous as to whether the S is in the double bonded position, e.g. -OC(S)R, or in the ester position, e.g. -SC(O)R. Appellants have created some very specific choices, such as alkenyloxycarbonyl, or aralkylthiocarbonyl. There are no guideposts to these specific choices, and hence these lack description.

Lack of Description of substituents attached to the various X and Y choices

The same problem occurs in the list of substituents attached to the various X and Y choices. That is X and Y can be e.g. substituted alkenylthio group, where there is a list of substituents set forth in the claim (see Appendix, page 9, starting at line 14). Thus, there is a carboxyl at the fifth from last line of claim 15, and a thiocarboxyl at the start of the third from last line of the claim. These terms never appear in the lengthy lists of substituents in the

Art Unit: 1624

specification. Similarly, the ester and thioester choices which appear in the last 5 lines of claim 15 have the same problem as note above. Appellants respond that "it may not be possible that each and every combination of X and/or Y with the substituent disclosed may exist chemically..." but that issue, an enablement question, was never raised. The examiner isn't saying that this substituents can't exist on that X and Y choice, but rather that appellants have created new choices for the list of substituents.

Lack of Description of the definition of R₃

The amendment of July 13, 1999 broadened the definition of R₃ so that it now reads "being a protective group easily removed therefrom". This is broader than the specification's language. Appellants point to Page 13, line 13 et seq. This says, "The group represented by R₃ is not particularly limited, only if it can eliminate from the esterified carboxyl group through hydrolysis or under conditions of the selective procedure according to the type of esters...." Examples follow. This language in the specification is substantially garbled. The first part makes it clear that this is a group which can be hydrolyzed. The rest --- "or under conditions of the selective procedure according to the type of esters" --- is very vague. It appears that some sort of selectivity is required in the procedure. But the claim does not have such a limitation. It covers removable under any type of procedure, so long as it is easy to do. The specification doesn't really go that far. It seems to say that the removal must be done either by hydrolysis, or must be done under some sort of selective procedure. These limitations do not appear in the broadened language of the claim.

Art Unit: 1624

Indefiniteness of "easily removed"

The language of "easily removed" means that the claim is not to cover groups which can only be removed with difficulty. But where is the line between the two? The specification gives no guidance, because, as noted in the above point, the term is nowhere present. Hence, the term is indefinite as well.

For the above reasons, it is believed that the rejections should be sustained.



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